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Arguments

Claims 1, 3, 8, 10, 22, 24 and 28 are herein amended. Claims 2, 9 and 23 are herein canceled. Claims 1, 3-8, 10-14, 22, and 24-28 are pending in the application. Applicants have amended the claims in order to clarify them. For at least the reasons stated below, applicants believe that all claims are in condition for allowance as they are not obvious over the cited references.

A. The amended claims are supported by the specification.

In section 3 of the office action, claims 1-14 and 22-28 are rejected under 35 USC § 112, first paragraph, for containing the term "manufacturing service provider data structures". The office action states that this term was not described in the specification at the time the application was filed.

Originally, the claims included "service provider data structures" as elements. To clarify the intent of the claims, applicants presented the former amendments so that the elements were described as "manufacturing service provider data structures". This is rejected in the office action as the term is not in the specification. Applicants now clarify the claims by amending the elements to be "Contract Manufacturing Organization data structures".

From the beginning of the detailed description, the specification teaches that by using the invention, "a user is matched to a service provider utilizing a database having information on service providers" (page 8, lines 5-6). The invention includes "a database of trusted CMO's" (page 9, line 8). "For contract manufacturing organizations, [(i.e., CMOs)], the present invention posts information concerning the contract manufacturing organization's capabilities surrounding contract manufacturing ... and assists the organization in selling their organization to pharmaceutical companies looking for a contract manufacturer" (page 9, lines 23-27). Figure 4 shows that the invention includes "a matchmaking utility 402 [between] pharmaceutical companies 404 and contract manufacturing organizations 406" (page 21, 21-22). As these citations show, the specification supports the use of the term "Contract Manufacturing Organization data structures". Applicants respectfully request that the rejections under 35 USC § 112, first paragraph, be withdrawn.

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B. The amended claims are not indefinite.

In section 4 of the office action, claims 1-14 and 28 are rejected under 35 USC § 112, second paragraph, for failing to "recite a useful connection between the identified hyperlink and additional information to be obtained from this hyperlink with the manufacturer service provider", making the utility of "storing, identifying and sending the hyperlink" unclear, and thus making the claim indefinite. The office action states that even "if all the limitations with respect to hyperlinks are omitted the invention ... could stand alone."

Applicants have clarified the use of the hyperlinks by amending the claims. Now, element 1(e), for example, claims:

"allowing the user to obtain additional information about the Contract Manufacturing Organization identified by the Contract Manufacturing Organization data structure utilizing the identified hyperlink"

In other words, when the user is shown information about a particular Contract Manufacturing Organization, the user can click on the hyperlink to discover additional information about that organization. This amendment is supported by the specification, which teaches that the user "is then sent the identified ... data structure and the identified link. Finally, the user is allowed to obtain additional information utilizing the identified link" (page 4, lines 9-11). As the specification supports the clarification of the use of hyperlinks in the invention, applicants request that the rejections be withdrawn.

In section 4.2, claims 2, 9 and 23 were also rejected under 35 USC § 112, second paragraph, for being indefinite. These claims have been canceled and so applicants ask that the rejection be withdrawn.

C. The claims are patentable over Thackston in view of Bissonette and Elance.

In section 6.1 of the office action, claim 1-2, 4-9, 11-14, 22-23 and 25-28 are rejected under 35 USC § 103(a) as unpatentable over Thackston in view of Bissonette and further in view of Elance. Applicants oppose this rejection and assert that the claims, as amended, are in allowable form.

The office action states on page 9 that Thackston teaches elements (f) and (h) at column 5 line 30 through column 6 line 9. Elements (f) and (h) generally provide that the system "receiv[es] order information for a new order from the user" and "placing the new

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order with the particular Contract Manufacturing Organization if the cost of the new order is within the budget constraints." Thackston does not suggest or teach these elements.

Thackston teaches an "electronic bidding system" (col. 9 lines 55-56) in which the user submitted a "request for quote RFQ or request for proposal RFP ... so that fabricators can submit proposals" (col. 9 lines 55-61). There is no teaching of the user "placing the new order" – the only activity contemplated by Thackston is of the user asking for bids.

Thackston, Bisonette and "budget constraints"

The office action admits that Thackston does not check "budget constraints, wherein budget constraints are calculated by comparing cost of the new order plus past order costs against an ordering budget to determine whether the cost of the new order would exceed the ordering budget; and placing the new order ... if the cost of the new order is within the budget constraints" (elements g and h). Instead, the office action relies on Bissonette (col. 5, lines 42-51).

Bissonette teaches an approval process for a credit card transaction, which may include checking to see if the transaction "would cause a budget item to be exceeded" and if so then "the transaction can be flagged for internal resolution. The system can be configured to go ahead and authorize payment for the purchase or it can be held" (col. 5, lines 48-53).

The office action states that Bisonette is "in the same field of endeavor" as Thackston and that it would have been obvious to combine the teachings of Bissonette with Thackston because "it would ensure that the purchase amount is within the allocated funding otherwise the transaction is flagged for internal resolution" (page 10).

Applicants respectfully submit that the office action does not establish *prima facie* obviousness because the reason cited for combining the references is specious. The reason provided in the office action is merely a restatement of what Bisonette teaches with regard to credit cards. In other words, the office action admits that Thackston "does not disclose checking budget constraints, wherein budget constraints are calculated... etc.". There is no motivation offered why the person skilled in the art would investigate Thackston's system for the manufacture of designed parts and then be motivated to look to the credit card system of Bisonette for the budget constraint issue.

The Federal Court has agreed that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

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suggests the desirability of the combination. *in re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thackston has no suggestion of desirability of the combination with Bisonette and Bisonette has no suggestion no desirability of the combination with Thackston. Applicants assert that there is no motivation to combine the Thackston, Bisonette and Elance references. Applicants respectfully request that a proper assertion of the motivation to combine the references be made or else the rejections be withdrawn, since the references (alone or in combination) fail to teach or suggest all of the elements of the claims.

D. The standard procedures have not been followed by the patent office.

Applicants file this paper in response to the office action and understand that the appeal process has not been started. While the applicants have in good faith filed this response, applicants wish to include in the file history information regarding the non-entered appeal brief.

A final office action was mailed 1 September 2004. On 29 October 2004, applicants filed a response. On 8 November 2004, an advisory action was mailed. Applicants then filed a Notice of Appeal on 22 November 2004.

Applicants desired to resolve the rejections with the examiner instead of filing an appeal brief. Unfortunately, the examiner assigned to this case retired and the case was passed to another examiner. That examiner agreed to revisit the rejections once applicants filed a supplemental response. Such a supplemental response was filed on 2 February 2005. However, no action was performed by the newly assigned examiner and so applicants filed an appeal brief on 31 May 2005. By this time, the case was reassigned to yet another examiner. On 9 June 2005, the present office action was mailed. Because the office action was mailed just days after the submission of the appeal brief, applicants assumed that the documents crossed in the mail.

In August 2005, the undersigned spoke with the examiner twice to determine how to proceed since there was both an outstanding appeal and an outstanding office action. On 9 September 2005, the undersigned spoke with a supervisory examiner (Wynn Coggins) to correct the issue of the two outstanding items. Examiner Coggins was very helpful and determined that the appeal brief was never entered because the undersigned had not signed the appeal brief. This was the first time that the undersigned was made aware of the unintentional signature problem. Since it had been more than 9 months since the notice

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of appeal was filed, Examiner Coggins determined that the appeal issue was moot and therefore applicants should submit a response to the outstanding office action.

Applicants respectfully point out, for the record's sake, that the patent office failed to follow the CFR rules when rejecting the appeal brief. Section 1.192(d) of 37 CFR clearly states that "if a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief." Furthermore, under the "REVIEW OF BRIEF BY EXAMINER" section of MPEP § 1206, the patent office procedure states:

"if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given the longest of any of the following time periods to correct the defects: (A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer; (B) within the time period for reply to the action from which appeal has been taken; or (C) within 2 months from the date of the notice of appeal under 37 CFR 1.191. Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The examiner may use the form paragraphs set forth below or form PTOL-462 ... to notify appellant that the appeal brief is defective. ...

¶12.12 Brief Defective – Unsigned

The appeal brief filed on [1] is defective because it is unsigned. ... A ratification properly signed is required. ..."

Based on this research, applicants respectfully point out that when 31 May 2005 appeal brief was found to be lacking a signature, the applicant-appellants should rightly have been given notice and an opportunity to correct the deficiency.

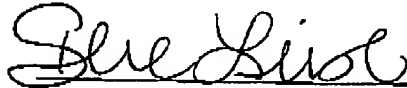
E. Summary

Since the rejections to the independent claims have been addressed, applicants submit that all pending claims are in condition for allowance. Applicants respectfully request reconsideration of the claims and ask that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7508. If any fees are due

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in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Attorney Docket # 060021-358401).

Respectfully submitted,



Steven C. Lieske, Reg. No. 47,749
Customer No. 29,838

OPPENHEIMER WOLFF & DONNELLY LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55405
Phone: 612-607-7508
Fax: 612-607-7100
E-mail: SLieske@oppenheimer.com